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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,532	01/10/2001	Geoffrey B. Rhoads	60244	9755

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DIGIMARC CORPORATION
19801 SW 72ND AVENUE
SUITE 250
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EXAMINER

NGUYEN, SIMON

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 04/05/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/758,532

Applicant(s)

RHOADS, GEOFFREY B.

Examiner

SIMON D NGUYEN

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 6 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5, 7-20, drawn to a videophone, classified in class 455, subclass 552.1.
 - II. Claim 6, drawn to a method of initiating purchase of an item by a consumer, classified in class 705, subclass 26.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions because the invention I relates to a cellular phone having a camera for capturing image and the invention II relates to a method of initiating purchase of an item.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. William Y. Conwell on 3/29/04 a provisional election was made without traverse to prosecute the invention of group I,

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claims 1-5, 6-20. Affirmation of this election must be made by applicant in replying to this Office action. Claim 6 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Drawings

6. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

Applicant is given a TWO MONTH time period to submit a drawing in compliance with 37 CFR 1.81. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit a drawing will result in **ABANDONMENT** of the application.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 1, 3-5 are rejected under 35 U.S.C. 102(a) as being anticipated by Reelee et al. (5,893,037).

Regarding claim 3, Reelee discloses a wireless camera/telephone device (fig.5) comprising: a wireless telephony device including a microphone (# 64), a modulator (inherently in a transmitter), a display screen (#20), and an RF amplifier (inherently in a transceiver), the device serving to receive audio and transmit an RF signal; an image capture device (camera) including an optical sensor (44) having plural sensing elements, and a lens (12) for imaging an object onto the sensor; wherein the screen (20) of the telephony device is used to present image data originating from the image capture device (fig.5, column 4 line 47 to column 6 line 10).

Regarding claim 1, this claim is rejected for the same reason as set forth in claim 3.

Regarding claims 4-5, Reelee further discloses a processing circuitry (50 of fig.5) for process data from the image capture camera for display by the display screen (column 5 line 21-24, 40-45) wherein the processing circuitry inherently includes a CPU.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 2, 7-8, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reelee et al. (5,893,037) in view of Ray (6,192,257).

Regarding claim 7, Reelee discloses a wireless camera/telephone device (fig.5) comprising: a wireless telephony device including a microphone (# 64), a modulator (inherently in a transmitter), a display screen (#20), and an RF amplifier (inherently in a transceiver), the device serving to receive audio and transmit an RF signal; an image capture device (camera) including an optical sensor (44) having plural sensing elements, and a lens (12) for imaging an object onto the sensor; wherein the screen (20) of the telephony device is used to present image data originating from the image capture device (fig.5, column 4 line 47 to column 6 line 10). However, Reelee does not specifically disclose a processor for encoding plural-bit data photographically within image data.

Ray discloses a videophone having a processor (452) and an encoder (414) wherein the processor for encoding plural-bit data steganographically within image data (fig.4, column 4 lines 6-27). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have Reelee, modified by Ray to digitize a captured image in order to improve the quality of the picture.

Regarding claims 2, 8, in the modified Reelee system, Ray discloses the processor processes operation based on the plural-bit data (fig.4, column 4 lines 6-51, column 8 lines 45-53).

Regarding claims 15-16, in the modified Reelee system, Reelee further discloses a controller (#50 of fig.5) (inherently including a processor)) for directs the device to

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transmit the image to a remote system and a memory for storing this image (column 5 lines 1-49).

11. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray (6,192,257) in view of Alperovich et al. (6,317,609).

Regarding claim 17, Ray discloses a method for operating a cell phone (fig.5, abstract), comprising:

Capturing image data using a 2D image sensor included with the cell phone and discerning plural-bit data steganographically encoded in the image data and communicating between a cell phone with a remote system via a cellular network (column 2 lines 5-25, column 4 lines 6-27, figs. 1, 4). It should be noted that Ray' cell phone sending the image and voice to other user (column 2 lines 5-25). however, Ray does not specifically disclose an identify of the remote system.

Alperovich discloses a video phone (20a) sends a captured image and voice to an identified cell phone (20b) via a cellular system (fig.4). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have Ray, modified by Alperovich in order to establish the video phone communication with an identified remote user.

Regarding claims 18-20, in the modified Ray system, Alperovich further discloses the remote system is another cell phone (fig.4), a computer (fig.5), a location of the cell phone, a location of an identified remote system (column 1 line 55 to column 2 line 23). Therefore, it would have been obvious to one skilled in the art at the time the invention

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was made to have Ray, modified by Alperovich in order to establish the video phone communication with a defined remote user.

12. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reelee et al. (5,893,037) in view of Ray (6,192,257) as applied to claim 8, and further in view of Alperovich et al. (6,317,609).

Regarding claims 9-11, the modified Reelee system fails to teach the information transmitting/receiving via Internet.

Alperovich discloses a communication link between a mobile terminal to a mobile computer for sending or receiving image and voice call through Internet (abstract, fig.4-5). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have Ray, modified by Alperovich in order to send or receiving image and voice call via Internet.

13. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reelee et al. (5,893,037) in view of Ray (6,192,257) and Alperovich et al. (6,317,609) as applied to claim 11, and further in view of Reitmaa et al. (WO 98/48548).

Regarding claims 11-14, the modified Reelee system discloses subject matter in these claims, wherein the image/voice communication links between a first terminal to a second terminal (figs.4-5 of Alperovich) wherein the first and second terminals send/receive/display the image/voice signal (abstract, column 4 line 47-59). It should be noted that the mobile video-phone take pictures (first action), then moves to other

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location to take another pictures (second action), these different location pictures send to any destination (other mobile terminal or computer) as the user wants to. However, the modified Reelee fails to disclose a GPS.

Reitmaa discloses a videophone having a GPS for determining a location of the mobile (page 13 line 17). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have modified Reelee system, modified by Reitmaa in order to provide more location's accuracy of a mobile terminal than other techniques.

Response to Arguments

14. Applicant's arguments with respect to claims 1-5, 7-20 have been considered but are moot in view of the new ground(s) of rejection.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Nguyen whose telephone number is (703) 308-1116. The examiner can normally be reached on Monday-Friday from 7:00 AM to 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F. Urban, can be reached on (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-0377.

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Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Hand-delivered response should be brought to Crystal Park II,
2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Simon Nguyen

March 29, 2004

A handwritten signature in cursive script that reads "Simon Nguyen". The signature is written in dark ink and is positioned below the typed name and date.